



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,342	04/02/2004	Murray S. Toas	D0932-00457 [I-8882]	3304

8933 7590 08/03/2005

DUANE MORRIS, LLP  
IP DEPARTMENT  
ONE LIBERTY PLACE  
PHILADELPHIA, PA 19103-7396

EXAMINER
----------

DIXON, MERRICK L

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/817,342

Applicant(s)

TOAS ET AL.

Examiner

Merrick Dixon

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on telephonic election 6-15-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**MERRICK DIXON**  
**PRIMARY EXAMINER**

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4-11-05; 4-2-04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1774

1

Applicant election of claims 1-13 is acknowledged. Claims 14-24 are accordingly withdrawn.

2

The abstract of the disclosure is objected to because it contains the legal word, "comprising". Correction is required. See MPEP § 608.01(b).

3

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4

Claims 1,2,3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Qi( US 6851941 B2).

The cited reference teaches the claimed invention including a process for making shiplap edges in duct board comprising molding same edge and machining the resulting molded shiplap edge to a thickness- col 1, lines 15-27; col 2, lines 55-58; col 3, lines 24-32; col 6, lines 5-12; figs 1 and 10. concerning claim 2, the reference teaches forming increased density into the product by virtue of compressing the product with shoe(50)- col 6, lines 5-12. concerning claim 3, the reference teaches edge compression by the

Art Unit: 1774

shoe(50) in col 6, lines 8-12. concerning claim 10, the reference teaches forming additional shiplap edges in fig. 10:

5

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6

Claims 4,5,6,7,8,9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qi( US 6851941 B2) in view of Luongo(US 6391958 B1). The primary reference to Qi was discussed above. Inter alla. Although same reference substantially teaches the claimed process, the examiner was unable to find express teachings of the notoriously well known step (in the instant art) of grinding its product during it patented process. The secondary reference to Luongo, however, teaches that it is known in the art to machine (grind) duct board products, as taught by the primary reference, during its production. It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teaching to the secondary reference and utilize and manipulate such notoriously well known process operations, such as grinding, during the primary reference's process, in the absence of unexpected results. Such a combination would have been obvious motivated by the desire to cut production cost –

Art Unit: 1774

col 7, lines 20-24..Concerning claim 13, the secondary reference teaches grinding steps as discusse above. Concerning claims 7-9, although and it is submitted, the recited apparatus limitations do not affect the instant question for patentability , i.e, such question concerns process limitations( Ex parte Pfeiffer , 1962 C.D. 408(1961)), the primary reference however teaches adjustable device means in col 4, lines 10-30; col 3, lines 3-10. Likewise and concerning claims 4 and 5, it has long been held that to be entitled to weight in process claims, the recited structure limitations must affect the method in a manipulative sense and not amount to merely claiming its use, as in the instant case. Ex parte Pfeiffer, 1962 C.D. 408 (1961). Such claimed product thickness, are thus of no patentable consequences to such question. This position also applies to the claimed device limitations, claims 7-9, as is also discussed above. The primary reference, however, teaches a manipulated product thickness(128) via press (50)- see figure 10.

7

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noonan et al (US5783268) and Noonan et al(US 6270865 B1) are cited of interest for their respective teachings and additionally to show the state of the art.

8

Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The

Art Unit: 1774

faxing of all papers must conform with the notice published in the Official Gazette, 1096

O.G. 30 ( November 15, 1989). **NOTE: All facsimiles sent to the examiner's**

**personal fax number should be in draft-forms and will be treated as informal.**

**Same facsimiles will not be entered in the related applications unless**

**otherwise agreed and noted by the examiner.**

**The fax number for all other fascimile is 703-872-9306.**

Information about **the status of an application** may be obtained from the Patent

Information Retrieval system (**Private PAIR**).

Status inquires for **published applications** may be retrieved from either **Private PAIR**

or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic

Business Center at **866-217-9197**.

Any questions concerning the instant communication should be directed to Examiner

Dixon, at 571-272-1520, Mondays to Thursdays, between 12 noon and 8 PM, eastern

time . The examiner's supervisor, Mrs. Rena Dye, can be reached at 571-272-3186.



Merrick Dixon

Primary Examiner

Group 1700